



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/776,841

02/11/2004

Patrick J. Helland

13768.1304

3027

47973 7590 10/25/2010
WORKMAN NYDEGGER/MICROSOFT
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT

PAPER NUMBER

2493

MAIL DATE

DELIVERY MODE

10/25/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|---------------------------------------|--|
| Office Action Summary | Application No. 10/776,841 | Applicant(s) HELLAND ET AL. | |
| | Examiner MOHAMMAD A. SIDDIQI | Art Unit 2493 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-25 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-25 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 17-25 and 29 are presented for the examination. Claims 1-16, 26-28 and 30 have been cancelled.

Claim Rejections - 35 USC § 101

2. Claim 29 is rejected under 35 U.S.C. 101 because computer-readable medium appears in the preamble. The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. *See* MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination*

Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2.

The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals *per se*, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter. In an effort to assist the patent community in overcoming a rejection or potential rejection under 35 U.S.C. § 101 in this situation, the USPTO suggests the following approach. A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation “non-transitory” to the claim. *Cf. Animals – Patentability*, 1077 *Off. Gaz. Pat. Office* 24 (April 21, 1987) (suggesting that applicants add the limitation “non-human” to a claim covering a multi-cellular organism to avoid a rejection under 35 U.S.C. § 101). Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory embodiment because a signal *per se* is the only viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure. *See, e.g., Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 29 recites the limitation "the linked" in claim 29, line 12. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17-25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille et al. (6,484,196) (Hereinafter Maurille) in view of Baird et al. (5,226,143) (Hereinafter Baird).

7. As per claim 17, Maurille discloses a method that facilitates message processing, the method performed within a computer comprising one or more processors and computer system memory, the method comprising:

requesting one or more messages (issuing query in the message table, col 9, lines 29-31).

determining (upon receiving the message, col 10, lines 18-20) from information associated with the one or more message that each of the one or more message belongs to a conversation group [thread] (col 10, line 18- col 11, line 6, please see abstract for description of thread);

linking (updating message table and other related tables, col 10, line 18- col 11, line 6) the one or more messages by a unique group identifier (col 10, line 18- col 11, line 6, please see description of update queries where clause, it is commonly known in the relational database that each update requires a write lock);

locking the conversation group ("a system allows message locking (conversation history plus agreement capabilities)", col 2, lines 65-67), the lock preventing a disparate requestor from accessing the one or more messages linked by the unique group identifier [thread id] (fig 2, col 1, lines 25-30, col 2, lines 65-67);

providing exclusive serial access to the messages linked by the unique group identifier (thread id, fig 2 , col 15, lines 38-63) such that only one service can process linked message at any time (privacy, col 1, lines 25-30). Maurille further closes closing a thread makes private conversation to public conversation (closing a thread is equivalent to default commit or rollback that release all the locks, col 18, lines 9-37).

Maurille did not specifically disclose the when a reader has finished processing the linked messages, receiving a notification from the reader to release the lock; and releasing the lock on the conversation group.

However, Baird discloses requesting a lock (col 6, lines 19-25), providing exclusive serial access (col 6, lines 19-25), and when a reader has finished processing

Art Unit: 2493

the linked messages, receiving a notification from the reader to release the lock] (col 8, lines 27-40); and releasing the lock on the conversation group [page group] (col 8, lines 27-40). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Baird and Maurille. All the claimed elements (serialization [document object model] and preventing access by locking records, releasing locks [database, ANSI sql]) were known in the prior art and one skilled in the art would have combined the elements as claimed by known methods with no change in their respective functions and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

8. As per claim 18, the claim is rejected for the same reasons as claim 17, above. In addition, Maurille discloses receiving one or more related messages (issuing query in the message table, col 9, lines 29-31) associating the related messages with the conversation group (the process of associating includes updating relation in the related tables, 108, Fig 3A, col 10, lines 5-67).

9. As per claim 19, the claim is rejected for the same reasons as claim 17, above. In addition, Maurille discloses automatically updating the conversation group (144, fig 2) with incoming related messages (col 10, lines 30-35).

10. As per claim 20, the claim is rejected for the same reasons as claim 17, above. In addition, Maurille discloses utilizing a conversation group identifier (272, fig 2) to lock

Art Unit: 2493

the conversation group ("locking (conversation history plus agreement capabilities)" col 2, lines 65-67, col 10, lines 18-67, updating requires locking the records).

11. As per claim 21, the claim is rejected for the same reasons as claim 17, above. In addition, Maurille discloses storing the message in-order (142, fig 5B, message record M001 –M006)

12. As per claim 22, Maurille discloses receives a request for a message (issuing query in the message table, col 9, lines 29-31);

determining from information associated (upon receiving the message, col 10, lines 18-20) with the message that message belongs to a conversation [thread] (col 10, line 18- col 11, line 6, please see abstract for description of thread);

associating (updating message table and other related tables, col 10, line 18- col 11, line 6) the messages and other related messages with a conversation group identified by a unique group identifier (the process of linking includes updating relation in the related tables, 108, Fig 3A, col 10, lines 5-67);

locking the conversation group ("locking (conversation history plus agreement capabilities)" col 2, lines 65-67) via unique group identifier (col 10, line 18- col 11, line 6, please see description of update querie's where clause, it is commonly known in the relational database that each update requires a write lock).

providing exclusive access to one or more messages of the conversation group identified by the unique group identifier to the requestor (thread id, fig 2 , col 15, lines

Art Unit: 2493

38-63; privacy, col 1, lines 25-30). Maurille further closes closing a thread makes private conversation to public conversation (closing a thread is equivalent to default commit or rollback that release all the locks, col 18, lines 9-37).

Maurille did not specifically disclose the when a reader has finished processing the linked messages, receiving a notification from the reader to release the lock; and releasing the lock on the conversation group.

However, Baird discloses requesting a lock (col 6, lines 19-25), providing exclusive serial access (col 6, lines 19-25), and when the requestor has finished processing the linked messages, receiving a notification from the requestor to release the lock on the conversation group] (col 8, lines 27-40); and releasing the lock [page group] (col 8, lines 27-40) . It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Baird and Maurille. All the claimed elements (serialization [document object model] and preventing access by locking records, releasing locks [database, ANSI sql]) were known in the prior art and one skilled in the art would have combined the elements as claimed by known methods with no change in their respective functions and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

13. As per claim 23, claim is rejected for the same reasons as claims 22, above. In addition, Maurille discloses utilizing message identifiers (M001, M002, Fig 3B, col 10, lines 25-40) to determine whether messages are related (M001, M002, Fig 3B, col 10,

Art Unit: 2493

lines 25-40, same record owner).

14. As per claim 24, claim is rejected for the same reasons as claim 22, above. In addition, Maurille discloses receiving the conversation group identifiers to associate with the conversation group (142, fig 3B, col 10, lines 18-67).

15. As per claim 25, claim is rejected for the same reasons as claim 22, above. In addition, Maurille discloses dynamically updating conversation group with incoming related messages (142, fig 3B, col 10, lines 25-40).

16. As per claim 29, claim is rejected for the same reasons as claim 17, above. In addition, Maurille discloses a computer readable medium storing computer executable instructions which when executed upon one or more computer processors facilitate processing by causing the processors to perform the method of claim 17 (elements of fig 1).

Response to Arguments

17. Applicant's arguments with respect to claims 17 and 22 have been considered but are moot in view of the new ground(s) of rejection.

18. In response to applicants argument regarding U.S.C. 101 rejection. The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest

reasonable interpretation consistent with the specification during proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals *per se*, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter. In an effort to assist the patent community in overcoming a rejection or potential rejection under 35 U.S.C. § 101 in this situation, the USPTO suggests the following approach. A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation “non-transitory” to the claim. Cf. *Animals – Patentability*, 1077 Off. Gaz.

Art Unit: 2493

Pat. Office 24 (April 21, 1987) (suggesting that applicants add the limitation “non-human” to a claim covering a multi-cellular organism to avoid a rejection under 35 U.S.C. § 101). Such an **amendment would typically not raise the issue of new matter**, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory embodiment because a signal *per se* is the only viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure. See, e.g., *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998).

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2493

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD A. SIDDIQI whose telephone number is (571)272-3976. The examiner can normally be reached on Monday -Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MS

/Carl Colin/
Acting SPE of Art Unit 2493